

Permission to Record a Performance in the USA

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Keywords

California, copyright, Illinois, law, legal, New York, performance, permission, photograph, publicity, record, recording, right

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Introduction

This essay discusses the law requiring permission to record any performance in the USA. A performance could be music, entertainment, a college professor's lecture, or any other audiovisual work. A related topic, which is also discussed in this essay, is the legal right of a person to give permission before his/her name or image is exploited in a commercial, for-profit context. This essay combines two topics that interest me: (1) privacy law¹ and (2) copyright law.²

This essay presents general information about an interesting topic in law, but is *not* legal advice for your specific problem. See my disclaimer at <http://www.rbs2.com/disclaim.htm> . From reading e-mail sent to me by readers of my essays since 1998, I am aware that readers often use my essays as a source of free legal advice on their personal problem. Such use is *not* appropriate, for reasons given at <http://www.rbs2.com/advice.htm> .

I list the cases in chronological order in this essay, so the reader can easily follow the historical development of a national phenomenon. If I were writing a legal brief, then I would use the conventional citation order given in the *Bluebook*.

Overview

A performer (e.g., musician, magician, comedian, college lecturer, etc.) owns the legal right to determine who and when will record his/her performance, regardless of the recording medium used (e.g., photographic film, magnetic tape, digital recording, etc.). The misappropriation of a person's name or likeness for unjust enrichment of a defendant is known as "the right of publicity". RESTATEMENT SECOND TORTS, § 652C (1977), and RESTATEMENT UNFAIR COMPETITION, § 46 (1995).

Surprisingly, there are not a large number of reported cases on *unauthorized* recordings of performances. The following three cases are frequently cited:

- *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483, 487 (N.Y.Sup. 1950) (Opera broadcasts over radio were tape recorded and sold on gramophone records by defendant. Opera had contract with Columbia Records to issue authorized

¹ See my webpage at <http://www.rbs2.com/imisc.htm#privacy> .

² See my webpage on <http://www.rbs2.com/icopyr.htm> .

gramophone records. Plaintiff alleged, among other issues, “[D]efendants have [a]ppropriated and exploited for their own benefit the result of the expenditures, labor and skill of Metropolitan Opera and American Broadcasting as embodied in the broadcast performances.” Court enjoined defendants.), *aff’d*, 107 N.Y.S.2d 795, 797 (N.Y.A.D. 1951) (per curiam) (“Defendants’ acts, as alleged in the complaint, constitute a misappropriation of the work, skill, expenditure and good will of plaintiffs, and present a case of unfair competition.”);

- *Gieseeking v. Urania Records, Inc.*, 155 N.Y.S.2d 171, 172 (N.Y.Sup. 1956) (“A performer has a property right in his performance that it shall not be used for a purpose not intended, and particularly in a manner which does not fairly represent his service.”);
- *Zacchini v. Scripps-Howard Broadcasting Company*, 433 U.S. 562 (1977) (the leading case in the USA on permission needed to record a performance, but this case is mostly concerned with alleged conflict with “freedom of the press”);
- *D’Amario v. Providence Civic Center Authority*, 639 F.Supp. 1538, 1544 (D.R.I. 1986) (In case involving prohibiting cameras at rock music concerts at Civic Center: “Few would question the rights of a singer to prohibit the unauthorized recording, and subsequent commercial exploitation, of her songs.”), *aff’d without opinion*, 815 F.2d 692 (1stCir. 1987), *cert. den.*, 484 U.S. 859 (1987);

A related topic is the legal right of a person to give permission (and be paid) before his/her name or image is exploited in a for-profit context.³ Examples that come to mind are the picture of Uncle Ben on a box of rice, the picture of Aunt Jemima on a box of pancake mix, the picture of Betty Crocker on a box of cake mix, as well as endorsements of products by celebrities.

A person does *not* need to give permission before their photograph is used in reporting news. However, journalists and the news media can be liable if a news report is either defamatory⁴ or a violation of the victim’s privacy.⁵

³ RESTATEMENT SECOND TORTS, § 652C (1977), and RESTATEMENT UNFAIR COMPETITION, § 46 (1995).

⁴ Defamation is discussed in Restatement Second Torts, §§ 558 to 652 (1977).

⁵ Privacy torts are discussed in Restatement Second Torts, §§ 652A to 652E (1977).

Zacchini

- *Zacchini v. Scripps-Howard Broadcasting Company*, 1975 WL 182619 (Ohio App. 1975) (per curiam),
- *rev'd*, 351 N.E.2d 454 (Ohio 1976),
- *rev'd*, 433 U.S. 562 (1977),
- *on remand*, 376 N.E.2d 582 (Ohio 1978).

Zacchini was a circus performer who was shot out of a cannon and flew 200 feet into a net. His entire performance took only 15 seconds. When the circus came to Burton, Ohio, television station WEWS in Cleveland⁶ videotaped Zacchini's performance and showed the entire performance on the WEWS 23:00 news broadcast. The television station misappropriated Zacchini's *entire* work product. Zacchini sued the television station for misappropriation of his act, seeking \$25,000 in damages.⁷ A trial court in Ohio granted summary judgment for the television station. An intermediate appellate court in Ohio reversed the summary judgment, but the Ohio Supreme Court reinstated the summary judgment. *Zacchini v. Scripps-Howard Broadcasting Company*, 1975 WL 182619 (Ohio App. 1975) (per curiam), *rev'd*, 351 N.E.2d 454 (Ohio 1976). The U.S. Supreme Court held in a 5 to 4 decision that the First Amendment protection of freedom of the press under federal constitutional law "do not immunize the [news] media when they broadcast a performer's entire act without his consent". *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575 (1977).⁸ On remand, the Ohio Supreme Court decided to follow the U.S. Supreme Court, instead of grant higher protections to journalists in Ohio. *Zacchini v. Scripps-Howard Broadcasting Co.*, 376 N.E.2d 582, 583 (Ohio 1978). The final result in the trial court is unknown and no further appeals are reported in Westlaw.

A freelance reporter attended Zacchini's performance on 30 Aug 1972. Zacchini asked the reporter *not* to film the performance, and the reporter complied with that request on that one day. However, the producer of the WEWS news program ordered the reporter to videotape the performance on 31 Aug, and the reporter returned and videotaped the performance. The performance was broadcast on 1 Sep. *Zacchini*, 351 N.E.2d at 455 (Ohio 1976); 433 U.S. at 564. These facts show that WEWS deliberately and willfully violated Zacchini's legal rights, because they *knew* Zacchini objected to the recording of his performance. This willfulness is in addition to the commercial exploitation by WEWS of Zacchini's performance. Not only did WEWS *not* have permission from Zacchini, WEWS knew Zacchini had refused permission.

⁶ *Zacchini*, 351 N.E.2d at 455 (Ohio 1976).

⁷ *Zacchini*, 433 U.S. at 575, n.12 (1977).

⁸ The Syllabus prepared by the U.S. Supreme Court says "news media" (*Zacchini*, 433 U.S. at 562), while the text of the opinion omits "news".

Zacchini not about copyright

Before discussing this case, let us be clear that this case is *not* about copyright. This case arose from events in the year 1972, when the Copyright Act of 1909 was in effect. Zacchini's performance itself was not copyrightable material, because his performance was not a Writing,⁹ and because his performance could *not* be registered with the Copyright Office, as required by 17 U.S.C. §§13-14. While photographs or motion picture film were copyrightable, the Copyright Act of 1909 required registration for copyright to attach. I do not know if the television station registered the copyright on the 15 seconds of film in their news broadcast.

If we apply current law to the facts of this case, Zacchini did *not* own a copyright in his performance, because his performance was not "fixed in any tangible medium of expression". 17 U.S.C. § 102(a) (enacted 1976).¹⁰ The current law, 17 U.S.C. §102(a) says that copyright automatically attaches when a work is "fixed in any tangible medium of expression". It might seem that a film or videotape of Zacchini's performance made by the television station would be copyrightable, but there is a condition hidden in the definition of "fixed", 17 U.S.C. §101, that requires either the author (e.g., Zacchini) do the fixation or that the author consent to the fixation.¹¹ The television station recorded Zacchini's performance without his permission, thus the television station owns no copyright on their fixation of Zacchini's performance. However, no one is alleging copyright infringement in this case.

There is an alternative reason why Zacchini did not own a copyright in his performance under current law. His performances were transitory, ephemeral, or evanescent events. Copyright is for something permanent and stable, such as a manuscript on paper, a printed book or periodical, a computer file, a photograph, a gramophone record, a compact disk, That is the essence of the fixation requirement in 17 U.S.C. §102(a).

discussion of judicial opinions

The intermediate appellate court in Ohio held:

The performance which constitutes an "act" is the product of the actor's talent and is his property. And, if his act is appropriately considered a dramatic or creative production, it involves a property right entitled to the same protection under the common law as any other property right. [citations and footnote 11 omitted]

It happens the plaintiff's total performance consumed only fifteen seconds. This is what defendant captured on tape and televised. Such a taking is no different generically from taping and broadcasting the total performance by a violin virtuoso, a full performance by a leading

⁹ See U.S. Constitution, Art. I, §8, cl. 8; and 17 U.S.C. §4 (repealed 1977).

¹⁰ *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675, n.22 (7thCir. 1986) ("Assuming that Zacchini did not videotape or otherwise record his performance, his human cannonball act would not be fixed in tangible form and could not be copyrighted. Nonetheless, because the work in which he asserts rights would not be fixed in a tangible medium of expression, his right of publicity in his performance would not be subject to preemption [by 17 U.S.C. §301].").

¹¹ *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675, n.22 (7thCir. 1986), *cert. den.*, 480 U.S. 941 (1987).

opera company or a complete program by the first tenor of the world. Plaintiff's act is clearly the dramatic product of his talent and, therefore, a property right. Moreover the prospect of a total performance being captured on audio-visual tape without permission and then repeated on television without legal redress puts the consequences of such an appropriation of property in a rather appalling perspective.

Of course, total appropriation is distinguishable from mere announcements of dramatic and entertaining events beforehand or critical reviews afterward. There is little quarrel with the proposition that the announcement or the review is newsworthy and protected by the First Amendment. It seems equally clear that the full performance is artistic property which cannot be taken from the artist or performer without giving rise to a cause of action. If the appropriating action needs a title in tort, conversion will do.

....

We hold that an intangible such as the performance of the plaintiff in this case is properly subject to protection from illegal conversion.

Zacchini v. Scripps-Howard Broadcasting Company, 1975 WL 182619 at *3-*4 (Ohio App. 1975).

The U.S. Supreme Court majority opinion in *Zacchini* says:

The broadcast of a film of petitioner's entire act poses a substantial threat to the economic value of that performance. As the Ohio court recognized, this act is the product of petitioner's own talents and energy, the end result of much **time, effort, and expense**.¹² Much of its economic value lies in the 'right of exclusive control over the publicity given to his performance'; if the public can see the act free on television, it will be less willing to pay to see it at the fair. [footnote omitted] The effect of a public broadcast of the performance is similar to preventing petitioner from charging an admission fee. "The rationale for (protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." Kalven, *Privacy in Tort Law Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMPORARY PROBLEMS 326, 331 (1966). Moreover, the broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purposes of trade or the incidental use of a name or picture by the press, goes to the heart of petitioner's ability to earn a living as an entertainer. Thus, in this case, Ohio has recognized what may be the strongest case for a 'right of publicity' involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.

Of course, Ohio's decision to protect petitioner's right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court. [citing *Mazer v. Stein*, 347 U.S. 201 (1954).] *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575-576 (1977).

¹² Boldface added by Standler to emphasize the protection of labor, skill and expense. In copyright law, this is known as a "sweat of the brow" case.

Note that there is *no* issue of prior restraint of journalists in this case. “Indeed, in the present case [Zacchini] did not seek to enjoin the broadcast of his act; he simply sought compensation for the broadcast in the form of damages.” *Zacchini*, 433 U.S. at 573-574. “[Zacchini] does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it.” *Zacchini*, 433 U.S. at 578.

In my search of U.S. Court of Appeals opinions on 21 April 2013, I found only one case that mentions *Zacchini* in the context of legally protecting facts. *Iowa State University Research Foundation, Inc. v. American Broadcasting Companies, Inc.*, 621 F.2d 57, 61 (2dCir. 1980) (“The public interest in the free flow of information is assured by the law’s refusal to recognize a valid copyright in facts. Cf. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 569, 97 S.Ct. 2849, 2854, ... (1977) (under state statute analogous to copyright law, television newscast could report fact of performance, but could not broadcast actual event without compensating performer).”).

causes of action

The judges on the Ohio Supreme Court, and also the justices of the U.S. Supreme Court, spoke of Zacchini’s “right to publicity”. This is a muddling of some obscure areas of law. To a purist, the “right of publicity” *only* protects against unauthorized commercial exploitation of a person’s name or likeness, as explained beginning at page 10, below. But in *Zacchini* what was taken was Zacchini’s entire performance. A law professor explained:

In my view, it is a very serious mistake to characterize the interest Zacchini sought to vindicate here as a “right of publicity.” The “right of publicity” protects a celebrity’s interest in the economic value of his *identity*. What Zacchini complained of was the appropriation of the economic value of his *performance*, not the marketable *public image* he had perhaps acquired through the success of that performance. Following Douglas Baird’s suggestion, I would refer to the type of right involved in *Zacchini* as a “right of performance.” See Douglas G. Baird, Note, Human Cannonballs and the First Amendment: *Zacchini v. Scripps Howard Broadcasting Co.*, 30 STANFORD LAW REVIEW 1185, 1186, n.7 (1978) I would reserve the term “right of publicity” for the commercial value of identity. Michael Madow, “Private Ownership of Public Image: Popular Culture and Publicity Rights,” 81 California Law Review 127, 208, n. 395 (Jan 1993). [italics in original]

Beginning at page 9, below, I argue *Zacchini* should be argued as a common-law copyright case, so there is no need for Baird’s new cause of action called “right of performance”. An alternative cause of action is an unfair competition tort (e.g., misappropriation of Zacchini’s labor and skill), because both Zacchini and the television station were in the entertainment business.¹³

¹³ The television station would doubtless reply that it is in the news business, to get the benefit of First Amendment “freedom of the press”. But showing Zacchini’s entire performance was entertainment. The news part was the factual statement: “The circus is in town.”

While the equitable doctrine of unjust enrichment comes to mind, Zacchini probably lost much more money from one showing of his performance on television than the television station [unjustly] earned from the showing of his performance.

Zacchini is consistent with copyright cases

The U.S. Supreme Court in *Zacchini* made a passing remark about protecting Zacchini's "time, effort, and expense". *Zacchini*, 433 U.S. at 575. Copyright cases protecting this trilogy have a long history, going back to the year 1845. *Emerson v. Davies*, 8 F.Cas. 615, 619 (D.Mass. 1845) ("skill, labor, and expense"). In the context of copyright law, such cases were overruled in *Feist Publications v. Rural Telephone*, 499 U.S. 340, 352-353 (1991). See my essay, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf> (Feb 2009). Because *Zacchini* is **not** a copyright case, it should survive *Feist*.

Zacchini owned each of his performances. The unauthorized film of *Zacchini*'s performance was a copy of one entire performance. When the television station broadcast their film that showed *Zacchini*'s performance, they unfairly competed with *Zacchini* by misappropriating his labor, skill, and expense. Note that both *Zacchini* and the television station were in the business of entertaining their audience in approximately the same location, so they were business competitors. Because they shared the same potential audience, someone who saw *Zacchini*'s performance on the television news program would have less motivation to go to the circus and see another performance.

An analogy could be made with fair use in copyright law, in that the broadcast of the film by the television station destroyed the market value of the original work, the fourth factor in fair use analysis. 17 U.S.C. §107 and *Harper & Row v. The Nation*, 471 U.S. 539, 566-569 (1985). Another analogy could be made with fair use in copyright law, in that it is *never* fair use to copy an *entire* work.¹⁴ And consistent with copyright law, another performer could independently create an act in which he/she was fired out of a cannon and such independent work would *not* infringe *Zacchini*'s ownership of the fact(s) of his performance.¹⁵

¹⁴ See cases from U.S. Courts of Appeals cited in Standler, Fair Use: No Excuse for Wholesale Copyright Infringement in the USA, <http://www.rbs2.com/unfair.pdf> (2009).

¹⁵ See, e.g., Standler, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf> (Feb 2009), section titled "independent creation is neither infringement nor unfair".

An author who has a copyright on a manuscript has the exclusive right to determine when to publish that work,¹⁶ commonly by assigning the author's copyright to the publisher. Similarly, Zacchini had the right to determine when and who would record his performance on photographic film or videotape. If Zacchini authorized a recording of his performance, then Zacchini would probably choose to receive royalties from the sale or display of the copyrighted recording of his performance.

From this unconventional discussion of the U.S. Supreme Court's decision in *Zacchini*, this decision is consistent with copyright cases. Again, I emphasize that *Zacchini* is **not** a copyright case.

common-law copyright in *Zacchini* ?

The Ohio intermediate appellate court also suggested alternative grounds of common-law copyright in an unpublished performance, *Zacchini*, 1975 WL 182619 at *4-*5 (Ohio App. 1975), but that was rejected by the Ohio Supreme Court. *Zacchini*, 351 N.E.2d 454, 457 (Ohio 1976) ("Common law copyright has no application in this case."). However, this decision only affects Ohio, and does not represent common-law copyright in other states, such as California or New York. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001) ("To be sure, *Zacchini* [433 U.S. 562] was not an ordinary right of publicity case: the defendant television station had appropriated the plaintiff's entire act, a species of common law copyright violation.").

To answer the question of whether Zacchini's performance was (or is) protected by common-law copyright, I did more than twenty hours of legal research and eventually wrote a separate essay on the subject of common-law copyright at <http://www.rbs2.com/clc.pdf> . The short answer is yes, Zacchini's performance was protected by common-law copyright. And because his 31 Aug 1972 performance was not fixed with permission of Zacchini, that performance is still protected by common-law copyright under the Copyright Act of 1976. Each of Zacchini's performances will be protected by a separate common-law copyright, unless Zacchini authorizes a recording (i.e., fixation) of a performance. In exchange for authorizing a recording, Zacchini would presumably want to be paid royalties for each public showing of the recording.

If this case had been litigated in California, New York, or another state with well-developed common-law copyright jurisprudence, then Zacchini's attorneys should have included common-law copyright as a cause of action in the complaint, in addition to the other causes of action. However, given the hostility (i.e., ignorance) of the Ohio Supreme Court to common-law copyright, it was pointless to include a common-law copyright cause of action in Ohio.

¹⁶ In the USA this is known as the right of first publication, in other nations it is the moral right of disclosure. See Standler, "Moral Rights of Authors in the USA," <http://www.rbs2.com/moral.pdf> .

Restatement 2d Torts §652C

The Restatement Second of Torts says:

One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy.

RESTATEMENT (SECOND) OF TORTS § 652C (1977). A person's name or likeness is a property right, (§652C, comment *a.*) which distinguishes this tort from other privacy torts. This tort, amongst other things, remedies the commercial exploitation of "the reputation, prestige, social or commercial standing, public interest[,] or other values of the plaintiff's name or likeness." §652C, comment *c.*

Section 652C is *not* preempted by the Copyright Act of 1976 because a person's persona is not copyrightable material, because a persona is *not* a Writing.¹⁷ *Brown v. Ames*, 201 F.3d 654, 658 (5thCir. 2000).

One wonders why a privacy tort is applied to a public performance, like Zacchini's at a county fair. Privacy normally concerns conduct in a private place (e.g., inside either a house, physician's office, attorney's office, or clergyman's office), where one has a "reasonable expectation of privacy". The Ohio Supreme Court explained:

It seems, of course, somewhat anomalous for the plaintiff, who regularly performs in public before large crowds, to claim a right of privacy. The very purpose of a performer is to lure people to come watch him, and certainly the plaintiff hoped not for privacy, but for crowds of thrilled spectators. But there is no real anomaly; the 'privacy' which the performer seeks is personal control over commercial display and exploitation of his personality and the exercise of his talents. In other words, performers and other public figures wish to keep the benefits of their performances private, or at least to retain control over them in much the same way that any individual would wish to keep control over his name and face. Judge Jerome N. Frank has aptly called this aspect of privacy 'the right of publicity' [quoting from *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2dCir. 1953)]. *Zacchini*, 351 N.E.2d 454, 459 (Ohio 1976). While this is an answer to the question of why a privacy tort is applied to a public performance, a better answer is that the privacy tort is misapplied in *Zacchini*.

Suing for a privacy violation instead of commercial misappropriation of plaintiff's likeness can snatch defeat from the jaws of victory. A privacy right needs proof of injury to the plaintiff's feelings or invasion of the right to be let alone, while commercial misappropriation seeks payments of royalties for past and future uses of plaintiff's name or likeness. See, e.g., *O'Brien v.*

¹⁷ The word "Writing" appears in the Copyright clause of the U.S. Constitution. See, e.g., *Lugosi v. Universal Pictures*, 603 P.2d 425 at 448, 160 Cal.Rptr. 323 at 346 (Cal. 1979) (Bird, C.J., dissenting) ("The intangible proprietary interest protected by the right of publicity simply does not constitute a writing. Thus, congressional action has not preempted the recognition of common law protection for the right of publicity. Accord *Price v. Hal Roach Studios, Inc.*, 400 F.Supp. [836] at pp. 845-846 [(S.D.N.Y. 1975)].").

Pabst Sales Co., 124 F.2d 167, 170 (5th Cir. 1941), *cert. denied*, 315 U.S. 823 (1942); *Sharman v. C. Schmidt & Sons, Inc.*, 216 F.Supp. 401 (E.D.Pa. 1963). Privacy rights are *not* assignable and terminate on death. The right of publicity (violation of which is commercial misappropriation of plaintiff's name or likeness) is assignable, and — in some states — does not terminate on death. For more on the distinction between privacy and commercial misappropriation, see *Lugosi v. Universal Pictures*, 603 P.2d 425 at 437-439 (Cal. 1979) (Bird, C.J., dissenting) (“Accordingly, the gravamen of the harm flowing from an unauthorized commercial use of a prominent individual's likeness in most cases is the loss of potential financial gain, not mental anguish.”), quoted beginning at page 18, below. Celebrities now generally sue under RESTATEMENT THIRD UNFAIR COMPETITION §§ 46-47 (1995), while ordinary citizens sue under a right of privacy in RESTATEMENT SECOND OF TORTS, § 652C (1977).

cases

In a famous case in 1953, the U.S. Court of Appeals in New York City considered and rejected “defendant’s contention that ... a man has no legal interest in the publication of his picture other than his right of privacy, i.e., a personal and non-assignable right not to have his feelings hurt by such a publication.”

A majority of this court rejects this contention. We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made ‘in gross,’ i.e., without an accompanying transfer of a business or of anything else. Whether it be labelled a ‘property’ right is immaterial; for here, as often elsewhere, the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has pecuniary worth.

Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953). Quoted with approval in *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220-221 (2d Cir. 1978), *cert. den.*, 440 U.S. 908 (1979).

The following paragraph of *Haelan Laboratories* says:

This right might be called a ‘right of publicity.’ For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953). In this famous paragraph, the Second Circuit gave the tort a name (“right of publicity”) and suggested the assignment of this right in a contract would usually need to be an exclusive assignment.

In 1967, four famous professional golfers sued a board game for unauthorized use of their names and their factual profiles in a parlor game. Plaintiffs charged defendant had made an “unfair exploitation and commercialization of their names and reputations.” The court held for

plaintiffs. The opinion of the trial court contains a rich collection of citations to early cases of this kind and the history of the development of this right to privacy. *Arnold Palmer v. Schonhorn Enterprises, Inc.*, 232 A.2d 458 (N.J.Super.Ch. 1967).

property right

It is now well-established that a person has a property right in the commercial exploitation of his name, likeness, image, and/or persona.

- *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1206 (8thCir. 1969) (“Nor is it a matter of dispute that plaintiff has a valuable property right in his name, photograph and image and that he may sell these property rights. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2ndCir. 1953), *cert. denied*, 346 U.S. 816, 74 S.Ct. 26, 98 L.Ed. 343 (1953); *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5thCir. 1941), *cert. denied*, 315 U.S. 823, 62 S.Ct. 917, 86 L.Ed. 1220 (1942); *Sharman v. C. Schmidt & Sons, Inc.*, 216 F.Supp. 401 (E.D.Pa. 1963); *Munden v. Harris*, 153 Mo.App. 652, 134 S.W. 1076 (1911).”);
- *Acme Circus Operating Co., Inc. v. Kuperstock*, 711 F.2d 1538, 1541 (11thCir. 1983);
- *McFarland v. Miller*, 14 F.3d 912, 922 (3dCir. 1994) (Quoting *Canessa v. J.I. Kislak, Inc.*, 235 A.2d 62, 76 (N.J.Super.L. 1967): “New Jersey has always enjoined the use of plaintiff's likeness and name on the specific basis that it was a protected property right. [Citing *Edison v. Edison Polyform & Mfg. Co.*, 67 A. 392, 394 (N.J.Ch. 1907).]”);
- *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804 (Cal. 2001) (“The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility.”), *cert. den.*, 534 U.S. 1078 (2002);
- *Herman Miller, Inc. v. Palazzetti Imports and Exports, Inc.*, 270 F.3d 298, 325 (6thCir. 2001) (citing four authorities);
- *Meadows v. Hartford Life Ins. Co.*, 492 F.3d 634, 639 (5thCir. 2007) (“ ‘The tort of misappropriation of name or likeness ... creates property rights only where the failure to do so would result in excessive exploitation of its value.’ [*Matthews v. Wozencraft*, 15 F.3d 432, 438 (5thCir. 1994)] The excessive exploitation mentioned by the court refers to preventing the value reduction of one's property rights in his name or likeness due to the tortfeasor's use of these. *Matthews* at 438-39.”);
- *Valadez v. Emmis Communications*, 229 P.3d 389, 396 (Kan. 2010) (Quoting comment *b* to RESTATEMENT SECOND OF TORTS § 652I (1977): “Since appropriation of name or likeness is similar to impairment of a property right”). See also Restatement Second of Torts § 652C, comment *a* (“nature of a property right”).

A property right in the commercial exploitation of one's name and likeness is very different from torts for invasion of privacy, intrusion on solitude, publication of private facts, etc. With all due

respect to William Prosser,¹⁸ who I deeply admire for his work in privacy torts and products liability law, it was a mistake to include the commercial misappropriation of a person's name or likeness in the set of privacy torts. This mistake has created confusion amongst attorneys and judges.

New York Statute

There is no common-law right of privacy in New York State. Legal rights are found in state statutes:

A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.

Civil Rights Law § 50 (enacted 1909, current May 2013).

The following section provides for civil remedies, an injunction and/or damages:

Any person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided [§50] may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait, picture or voice, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if the defendant shall have knowingly used such person's name, portrait, picture or voice in such manner as is forbidden or declared to be unlawful by section fifty of this article, the jury, in its discretion, may award exemplary damages. But nothing contained in this article shall be so construed as to prevent any person, firm or corporation from selling or otherwise transferring any material containing such name, portrait, picture or voice in whatever medium to any user of such name, portrait, picture or voice, or to any third party for sale or transfer directly or indirectly to such a user, for use in a manner lawful under this article; nothing contained in this article shall be so construed as to prevent any person, firm or corporation, practicing the profession of photography, from exhibiting in or about his or its establishment specimens of the work of such establishment, unless the same is continued by such person, firm or corporation after written notice objecting thereto has been given by the person portrayed; and nothing contained in this article shall be so construed as to prevent any person, firm or corporation from using the name, portrait, picture or voice of any manufacturer or dealer in connection with the goods, wares and merchandise manufactured, produced or dealt in by him which he has sold or disposed of with such name, portrait, picture or voice used in connection therewith; or from using the name, portrait, picture or voice of any author, composer or artist in connection with his literary, musical or artistic productions which he has sold or disposed of with such name, portrait, picture or voice used in connection therewith. Nothing contained in this section shall be construed to prohibit the copyright owner of a sound recording from disposing of, dealing in, licensing or selling that sound recording to any party, if the right to dispose of, deal in, license or sell such sound recording has been conferred by contract or other written document by such living person or the holder of such

¹⁸ William Prosser, "Privacy," 48 CALIFORNIA LAW REVIEW 383 (1960). Prosser was also the initial Reporter for the RESTATEMENT SECOND OF TORTS, including the volume containing the privacy torts.

right. Nothing contained in the foregoing sentence shall be deemed to abrogate or otherwise limit any rights or remedies otherwise conferred by federal law or state law. Civil Rights Law § 51 (enacted 1903; amended in 1909, 1911, 1921, 1979, 1983, 1995; current May 2013).

The key phrases "advertising purposes" and "trade purposes" are defined:

Civil Rights Law § 51 authorizes a civil action for injunctive relief and damages where the name or likeness of any living person is used for advertising or trade purposes without the written consent of that person in violation of Civil Rights Law §50. As the Court of Appeals noted in *Arrington v. New York Times Co.*, 55 N.Y.2d 433, 439, 449 N.Y.S.2d 941, 434 N.E.2d 1319, *cert. denied*, 459 U.S. 1146, 103 S.Ct. 787, 74 L.Ed.2d 994, Civil Rights Law §§ 50 and 51 "were drafted narrowly to encompass only the commercial use of an individual's name or likeness and no more". "Advertising purposes" has been defined as "use in, or as part of, an advertisement or solicitation for patronage of a particular product or service" *Beverly v. Choices Women's Med. Center*, 78 N.Y.2d 745, 751, 579 N.Y.S.2d 637, 587 N.E.2d 275. "Trade purposes" is more difficult to define. See, *Davis v. High Society Mag.*, 90 A.D.2d 374, 379, 457 N.Y.S.2d 308), and involves use which would draw trade to the firm. See, *Flores v. Mosler Safe Co.*, 7 N.Y.2d 276, 284, 196 N.Y.S.2d 975, 164 N.E.2d 853.

Kane v. Orange County Publications, 649 N.Y.S.2d 23, 25 (N.Y.A.D. 1996), *leave to appeal denied*, 678 N.E.2d 502 (N.Y. 1997).

"Moreover, works of fiction do not fall within the narrow scope of the statutory definitions of 'advertising' or 'trade' " *Costanza v. Seinfeld*, 719 N.Y.S.2d 29, 30 (N.Y.A.D. 2001) (citing *Hampton v. Guare*, 600 N.Y.S.2d 57, 58 (N.Y.A.D. 1993) ("works of fiction and satire do not fall within the narrow scope of the statutory phrases 'advertising' and 'trade' ")), *leave denied*, 625 N.E.2d 590 (N.Y. 1993)). In turn, *Hampton* cites *University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301 (N.Y.A.D. 1965), *aff'd*, *adopting opinion at App.Div.*, 207 N.E.2d 508 (N.Y. 1965).

There is a one-year statute of limitations that begins to run from the first public display (or first publication) of a photograph. *Nussenzweig v. diCorcia*, 878 N.E.2d 589 (N.Y. 2007).

In 1965, a judge in New York State summarized the law.

It is quite true that the principles of unfair competition as expanded in commercial cases have been applied by state courts in cases involving literary or artistic productions (*Metropolitan Opera Ass'n v. Wagner-Nichols R. Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483, *aff'd*, 279 App.Div. 632, 107 N.Y.S.2d 795; *Mutual Broadcasting System, Inc. v. Muzak Corp.*, 177 Misc. 489, 30 N.Y.S.2d 419; *Twentieth Century Sporting Club v. Transradio Press Service*, 165 Misc. 71, 300 N.Y.S. 159; *C. B. S., Inc. v. Documentaries Unlimited*, 42 Misc.2d 723, 248 N.Y.S.2d 809). In all of these cases the subject matter was not susceptible of copyright. The rendition of an aria, the technique of a virtuoso, or the delivery of an orator cannot be copyrighted. Until fairly recently their artistic endeavors were perishable and once given were forever lost. Now they can be mechanically recorded and, if so, the resultant disk or tape can be copyrighted. What these cases hold is that the performance may not be pirated by recording it and selling the recording without the

performer's permission. In reaching this conclusion the courts had before them a knotty problem not unlike that involved in the protection of an idea which is not patentable. In reaching the conclusion that the performance is entitled to protection from unauthorized mechanical reproduction, no question of the protection afforded copyrightable material is involved and the law evolved from the decisions cannot be applied to a copyright situation. Here it is indisputable that the film could have been copyrighted (U.S.C., Title 17, § 5; *Benny v. Loew's Incorporated*, 9 Cir., 239 F.2d 532, 535). Moreover, the plaintiff itself, as distinct from its licensor, could have copyrighted the translation making up the sound track (*Toksvig v. Bruce Pub. Co.*, 7 Cir., 181 F.2d 664).

Flamingo Telefilm Sales, Inc. v. United Artists Corp., 265 N.Y.S.2d 444, 447 (N.Y.A.D. 1965) (Steuer, J., dissenting). Note that federal copyright laws did not apply to sound recordings until the year 1972.

Note that the right of publicity in New York State is limited to living persons. There is no legal right in New York State for protection of the name or likeness of a dead person. Civil Rights Act, §50 ("any living person"); *Smith v. Long Island Jewish-Hillside Medical Center*, 499 N.Y.S.2d 167, 168 (N.Y.A.D. 1986); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 585 (2dCir. 1990).

The following cases in the New York Court of Appeals since 1984 have explained § 51 of the Civil Rights Act, which includes the right of publicity in New York State:

- *Gautier v. Pro-Football, Inc.*, 107 N.E.2d 485, 488 (N.Y. 1952) ("It has long been recognized that the use of name or picture in a newspaper, magazine, or newsreel, in connection with an item of news or one that is newsworthy, is not a use for purposes of trade within the meaning of the Civil Rights Law, *Sidis v. F-R Pub. Corp.*, 113 F.2d 806 [810 (2dCir. 1940)], *certiorari denied*, 311 U.S. 711 [(1940)]; *Humiston v. Universal Film Mfg. Co.*, 178 N.Y.S. 752 [(N.Y.A.D. 1919)]; [citing four other cases]");
- *Stephano v. News Group Publications*, 474 N.E.2d 580 (N.Y. 1984) (newsworthiness exception);
- *Freihofner v. Hearst Corp.*, 480 N.E.2d 349 (N.Y. 1985) (newsworthiness exception overpowers statutory confidentiality of pleadings in divorce court);
- *Caesar v. Chemical Bank*, 487 N.E.2d 275 (N.Y. 1985) (written consent required);
- *Finger v. Omni Publications Intern., Ltd.*, 566 N.E.2d 141 (N.Y. 1990) (newsworthiness exception);
- *Beverley v. Choices Women's Medical Center, Inc.*, 587 N.E.2d 275 (N.Y. 1991) (Abortion clinic published photograph of physician in their calendar without her permission.);

- *Howell v. New York Post Co., Inc.*, 612 N.E.2d 699 (N.Y. 1993) (Newspaper published photograph of a patient at private psychiatric facility without permission.);
- *Messenger ex rel. Messenger v. Gruner + Jahr Printing and Pub.*, 727 N.E.2d 549 (N.Y. 2000) (newsworthiness exception);
- *Nussenzweig v. diCorcia*, 878 N.E.2d 589 (N.Y. 2007) (statute of limitations).

California Statute

California has both a statute and common-law privacy. The statute about right of publicity says:

(a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney's fees and costs.

(b) As used in this section, "photograph" means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person, such that the person is readily identifiable.

(1) A person shall be deemed to be readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine that the person depicted in the photograph is the same person who is complaining of its unauthorized use.

(2) If the photograph includes more than one person so identifiable, then the person or persons complaining of the use shall be represented as individuals rather than solely as members of a definable group represented in the photograph. A definable group includes, but is not limited to, the following examples: a crowd at any sporting event, a crowd in any street or public building, the audience at any theatrical or stage production, a glee club, or a baseball team.

(3) A person or persons shall be considered to be represented as members of a definable group if they are represented in the photograph solely as a result of being present at the time the photograph was taken and have not been singled out as individuals in any manner.

(c) Where a photograph or likeness of an employee of the person using the photograph or likeness appearing in the advertisement or other publication prepared by or in behalf of the user is only incidental, and not essential, to the purpose of the publication in which it appears, there shall arise a rebuttable presumption affecting the burden of producing evidence that the failure to obtain the consent of the employee was not a knowing use of the employee's photograph or likeness.

(d) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

(e) The use of a name, voice, signature, photograph, or likeness in a commercial medium shall not constitute a use for which consent is required under subdivision (a) solely because the material containing such use is commercially sponsored or contains paid advertising. Rather it shall be a question of fact whether or not the use of the person's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required under subdivision (a).

(f) Nothing in this section shall apply to the owners or employees of any medium used for advertising, including, but not limited to, newspapers, magazines, radio and television networks and stations, cable television systems, billboards, and transit ads, by whom any advertisement or solicitation in violation of this section is published or disseminated, unless it is established that such owners or employees had knowledge of the unauthorized use of the person's name, voice, signature, photograph, or likeness as prohibited by this section.

(g) The remedies provided for in this section are cumulative and shall be in addition to any others provided for by law.

California Civil Code, § 3344 (enacted 1971, amended 1984, current May 2013).

The California Supreme Court explained:

The privacy tort seeks to vindicate multiple and different interests that range from freedom to act without observation in a home, hospital room, or other private place to the ability to control the commercial exploitation of a name or picture. RESTATEMENT 2D TORTS, §§ 652B; 652C; see also *Miller v. National Broadcasting Co.*, (Cal.App. 1986), 232 Cal.Rptr. 668 (television producer and camera crew entered home without permission to film unsuccessful efforts of paramedics to save the life of plaintiff's husband who had suffered heart attack); *Noble v. Sears, Roebuck & Co.*, 109 Cal.Rptr. 269 (Cal.App. 1973) (private investigator entered hospital room to interrogate patient); Civil Code, § 3344 (right to recover damages for knowing use of a person's name, photograph, likeness, voice, or signature for commercial exploitation; statutory right cumulative to the common law).

Hill v. National Collegiate Athletic Assn., 865 P.2d 633, 647 (Cal. 1994).

A two-year statute of limitations runs from first publication. *Christoff v. Nestle USA, Inc.*, 213 P.3d 132 (Cal. 2009).

The U.S. Court of Appeal in California wrote about photographs of newsworthy events:

Under both the common law cause of action and the statutory cause of action “no cause of action will lie for the publication of matters in the public interest, which rests on the right of the public to know and the freedom of the press to tell it.” *Montana v. San Jose Mercury News, Inc.*, 40 Cal.Rptr.2d 639, 640 (Cal.App. 1995) [citing *Dora v. Frontline Video, Inc.*, 18 Cal.Rptr.2d 790, 792 (Cal.App. 1993) and *Eastwood v. Superior Court*, 198 Cal.Rptr. 342, 349 (Cal.App. 1983)]. This First Amendment defense extends “to almost all reporting of recent events,” as well as to publications about “people who, by their accomplishments, mode of living, professional standing or calling, create a legitimate and widespread attention to their activities.” *Eastwood*, 198 Cal.Rptr. 342, 350 (Cal.App. 1983) [citing *Carlisle v. Fawcett Publications, Inc.*, 20 Cal.Rptr. 405, 414 (Cal.App. 1962)]. However, the defense is not absolute; we must find “a proper accommodation between [the] competing concerns” of freedom of speech and the right of publicity. *Id.*

Downing v. Abercrombie & Fitch, 265 F.3d 994, 1001 (9thCir. 2001).

Note that the U.S. Court of Appeals has held that this state statute is sometimes preempted by the federal Copyright Act of 1976. *Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134 (9thCir. 2006), *cert. den.*, 549 U.S. 1252 (2007).

Lugosi

Bela Lugosi played the part of Count Dracula in a 1930 motion picture by Universal Pictures. Lugosi died in 1956. Beginning in 1960, Universal Pictures began licensing Lugosi’s image or likeness as Count Dracula. The widow of Lugosi sued Universal. The trial court held for plaintiffs. *Lugosi*, 172 U.S.P.Q. 541 (Cal.Super. 1972). However, the appellate courts reversed, holding that Lugosi’s legal right to his likeness died with him. *Lugosi*, 139 Cal.Rptr. 35 (Cal.App. 1977), *aff’d*, 603 P.2d 425 (Cal. 1979). The California legislature then overruled the California Supreme Court in *Lugosi* by enacting in 1984 a statute, now Cal. Civil Code § 3344.1, that made the right of publicity descendible until 70 years after death. The only part of *Lugosi* that retains vitality is the elegant dissent by Chief Justice Bird.

Justice Bird distinguishes privacy torts from misappropriation of a person’s likeness:

The appropriation of an individual's likeness for another's commercial advantage often intrudes on interests distinctly different than those protected by the right of privacy. Plaintiffs in this case have not objected to the manner in which Universal used Lugosi's likeness nor claimed any mental distress from such use. Rather, plaintiffs have asserted that Universal reaped an economic windfall from Lugosi's enterprise to which they are rightfully entitled. *Lugosi v. Universal Pictures*, 603 P.2d 425 at 437, 160 Cal.Rptr. 323 at 335 (Cal. 1979) (Bird, C.J., dissenting).

Justice Bird continues:

Accordingly, the gravamen of the harm flowing from an unauthorized commercial use of a prominent individual's likeness FN10 in most cases is the loss of potential financial gain, not mental anguish. (See *Motschenbacher v. R. J. Reynolds Tobacco Co.* (9th Cir. 1974) 498 F.2d 821, 824; Prosser, *Supra*, 48 CAL.L.REV. at p. 406; Comment, Transfer of the Right of Publicity: Dracula's Progeny and Privacy's Stepchild (1975) 22 UCLA L.REV. 1103, 1104, fn. 8.) FN11 The fundamental objection is not that the commercial use is offensive, but that the individual has not been compensated. Indeed, the representation of the person will most likely be flattering, since it is in the user's interest to project a positive image. The harm to feelings, if any, is usually minimal. (See Note, *Zacchini v. Scripps-Howard Broadcasting Company: Media Appropriation, the First Amendment and State Regulation* (1977) UTAH L.REV. 817, 818-819.)

FN10. The present case indisputably involves the commercial use of the likeness of a prominent person. No opinion is expressed on whether the rights recognized herein apply to other individuals. (Compare *Ali v. Playgirl, Inc.*, *supra*, 447 F.Supp. at p. 729 with *Nimmer, Supra*, 19 LAW & CONTEMP. PROB. at p. 217 and *Treece, Supra*, 51 TEXAS L.REV. at pp. 643, fn. 27, 644-645.)

FN11. This is not to suggest that commercial misappropriations of one's likeness may not inflict noneconomic injuries. Commercial misappropriations may injure a person's feelings in several ways. First, the person may find any commercial exploitation undesirable and offensive. Second, while certain commercial uses may be acceptable or even desirable, a particular use may be distressing. (See, e. g., *O'Brien v. Pabst Sales Co.* (5th Cir. 1942) 124 F.2d 167, 170.) Third, other individuals, unaware that the use is unauthorized, may disparage one who would sell their identity for that purpose, thereby inducing embarrassment, anger or mental distress. (See generally, *Treece, Supra*, 51 TEXAS L.REV. at pp. 638-648; Note, *Community Property Interests in the Right of Publicity: Fame and/or Fortune* (1978) 25 UCLA L.REV. 1095, 1108-1109.) Further, any unauthorized use infringes on one's effort to control the public projection of one's identity, including the desire for solitude and anonymity.

The individual's interest thus threatened by most unauthorized commercial uses is significantly different than the personal interests protected under the right of privacy. Recognition of this difference has prompted independent judicial protection for this economic interest. The individual's interest in the commercial value of his identity has been regarded as proprietary in nature FN12 and sometimes denominated a common law "right of publicity." FN13 This right has won increasing judicial recognition, FN14 as well as endorsements by legal commentators. FN15

FN12. As one court observed nearly 70 years ago in recognizing the need to accord protection to the economic value in one's identity: "If there is value in (one's likeness), sufficient to excite the cupidity of another, why is it not the property of him who gives it the value and from whom the value springs?" (*Munden v. Harris* (1911) 153 Mo.App. 652, 134 S.W. 1076, 1078.)

FN13. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* (2d Cir. 1953) 202 F.2d 866, 868; Nimmer, *Supra*, 19 LAW & CONTEMP. PROB. 203.

FN14. See, e. g., *Factors Etc., Inc. v. Pro Arts, Inc.*, (2d Cir. 1978) 579 F.2d 215, 221; *Ali v. Playgirl, Inc.*, *supra*, 447 F.Supp. at pages 728-729; *Zacchini v. Scripps-Howard Broadcasting Co.*, (1977) 433 U.S. 562, 575-578, 97 S.Ct. 2849, 53 L.Ed.2d 965; *Factors Etc., Inc. v. Creative Card Co.*, *supra*, 444 F.Supp. at page 282; *Memphis Development Foundation v. Factors Etc., Inc.*, (W.D.Tenn. 1977) 441 F.Supp. 1323, 1330, *affirmed* (6th Cir. 1978) 578 F.2d 1381; *Lombardo v. Doyle, Dane & Bernbach, Inc.*, (1977) 58 A.D.2d 620, 396 N.Y.S.2d 661, 664; *Rosemont Enterprises, Inc. v. Urban Systems, Inc.*, *supra*, 72 Misc.2d 788, 340 N.Y.S.2d at page 146, *affirmed as modified* 42 A.D.2d 544, 345 N.Y.S.2d 17; *Grant v. Esquire, Inc.*, *supra*, 367 F.Supp. at page 880; *Uhlaender v. Hendricksen*, *supra*, 316 F.Supp. at pages 1280-1283; *Cepeda v. Swift & Co.*, (8th Cir. 1969) 415 F.2d 1205, 1206; *McQueen v. Wilson*, (1968) 117 Ga.App. 488, 161 S.E.2d 63, 65-66, *reversed on other grounds*, 224 Ga. 420, 162 S.E.2d 313; *Canessa v. J. I. Kislak, Inc.*, (1967) 97 N.J.Super. 327, 235 A.2d 62, 75-76; *Hogan v. A.S. Barnes & Co., Inc.*, (Pa.Ct.C.P.Phil.Cy. 1957) 114 U.S.P.Q. 314 (discussed in Note, *The Right of Publicity Protection for Public Figures and Celebrities* (1976) 42 BROOKLYN L.REV. 527, 535-536); *Ettore v. Philco Television Broadcasting Corp.*, (3d Cir. 1956) 229 F.2d 481, 487, 489-492; *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, *supra*, 202 F.2d at page 868; *U. S. Life Ins. Co. v. Hamilton*, (Tex.Civ.App. 1951) 238 S.W.2d 289, 292; *O'Brien v. Pabst Sales Co.*, *supra*, 124 F.2d at page 170 (dis. opn. of Holmes, J.); *Munden v. Harris*, *supra*, 134 S.W. at page 1079; *Edison v. Edison Polyform Mfg. Co.*, (1907) 73 N.J.Eq. 136, 67 A. 392.

Despite this increasing trend toward recognizing a distinct right to control the commercial exploitation of one's name and likeness, the development of this right has been spasmodic. This is in part a consequence of courts adjudicating claims which might be categorized as invasions of plaintiff's right of publicity as privacy claims. (See cases cited in fn. 20, Post.) The resulting confusion often noted by commentators, has impeded the development of the right. (See, e. g., Note, *Supra*, 29 HASTINGS L.J. at pp. 752-754; Gordon, *Right of Property in Name, Likeness, Personality and History* (1960) 55 Nw.U.L.REV. 553, 554, 606 et seq.; Note, *Supra*, 42 BROOKLYN L.REV. at pp. 527, 540-541.)

This confusion is due, in part, to the failure of litigants to delineate carefully the nature of the interest sought to be vindicated. However, a certain amount of equivocation is not surprising when the right of publicity is discussed as a variety of the right of privacy, a personal right, and then promptly described as a property right. The RESTATEMENT SECOND OF TORTS, for example, discusses the appropriation of a person's name or likeness under the rubric of the right of privacy. (§ 652C.) That right is deemed to be personal and nonassignable and to terminate upon death. (§ 652I.) However, the RESTATEMENT SECOND also states that the protection "appears . . . to confer something analogous to a property right upon the individual" (§ 652A, com. b), that the right to use one's name is assignable (§ 652C, com. a), and that survival rights may be held to exist (§ 652I, com. b).

FN15. See, e. g., Note, *Supra*, 29 HASTINGS L.J. at page 754; Note, *Supra*, 25 UCLA L.REV. at pages 1096, 1102-1109; Comment, *Privacy, Appropriation, and the First Amendment: A Human Cannonball's Rather Rough Landing* (1977) B.Y.U.L.REV. 579, 587; Note, *Supra*, 42 BROOKLYN L.REV. at page 545; Pember & Teeter, *Privacy and the*

Press since Time, Inc. v. Hill (1974) 50 WASH.L.REV. 57, 87-88; Treece, Supra, 51 TEXAS L.REV. at pages 647-648; Hofstadter & Horowitz, Supra, section 1.4, pages 1-7; Gordon, Supra, 55 NW.U.L.REV. 553.

Lugosi v. Universal Pictures, 603 P.2d 425 at 438-439, 160 Cal.Rptr. 323 at 336-338 (Cal. 1979) (Bird, C.J., dissenting).

Later in her dissent, Chief Justice Bird holds that the right of publicity is assignable:

The right of publicity protects the intangible proprietary interest in the commercial value in one's identity. Like other intangible property rights, its value often cannot be reaped if the individual may not transfer all or part of that interest to another for development. Indeed, an exclusive grant of publicity rights may be required before an attempt to use or promote that person's likeness will be undertaken. Since it is clear that the right of publicity is hardly viable unless assignable, I agree with the numerous authorities that have recognized the right is capable of assignment. FN29

FN29. See, e. g., *Factors Etc., Inc. v. Pro Arts, Inc.*, supra, 579 F.2d at page 221 [(2dCir. 1978)]; *Cepeda v. Swift & Co.*, supra, 415 F.2d at page 1206 [(8thCir. 1969)]; *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, supra, 202 F.2d at page 868 [(2dCir. 1953)]; Prosser, TORTS (4th ed. 1971) § 117, page 807; Gordon, supra, 55 NW.U.L.Rev. at page 611; Nimmer, supra, 19 LAW & CONTEMPORARY PROBLEMS at page 216.

Lugosi v. Universal Pictures, 603 P.2d 425 at 445, 160 Cal.Rptr. 323 at 343 (Cal. 1979) (Bird, C.J., dissenting). Given that the right of publicity is assignable, one needs permission to use a person's persona in a commercial context.

Illinois Statute

Illinois statute:

A person may not use an individual's identity for commercial purposes during the individual's lifetime without having obtained previous written consent from the appropriate person or persons specified in Section 20 of this Act or their authorized representative. 765 Illinois Compiled Statutes 1075/30 (effective 1999, current May 2013).

There is a one-year statute of limitations. *Blair v. Nevada Landing Partnership, App.*, 859 N.E.2d 1188 (Ill.App. 2006).

Trannel v. Prairie Ridge Media, Inc., 2013 IL App (2d) 120725, ¶16, --- N.E.2d ---- (Ill.App. 2013) ("To allege a common-law appropriation-of-likeness or right-of-publicity claim, a plaintiff had to set forth three elements: (1) an appropriation of one's name or likeness; (2) without one's consent; and (3) for another's commercial benefit.").

The U.S. Court of Appeals in Chicago has briefly (from Sep 2004 until May 2005), and erroneously, held that this state statute was preempted by the federal Copyright Act of 1976. *Toney v. L'Oreal U.S.A., Inc.*, 384 F.3d 486 (7thCir. 2004), *vacated*, 400 F.3d 964 (7thCir. 2005) (per curiam), *on rehearing* 406 F.3d 905, 908-910 (7thCir. 2005) (*not* preempted, rehearing en banc denied in footnote 4). In this case, a model sued a consumer hair-care product for the commercial use of her image in a photograph.

Applying the facts of this case to the requirements for preemption, we find that Toney's identity is not fixed in a tangible medium of expression. There is no "work of authorship" at issue in Toney's right of publicity claim.¹⁹ A person's likeness — her persona — is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this. From this we must also find that the rights protected by the IRPA [Illinois Right of Publicity Act] are not "equivalent" to any of the exclusive rights within the general scope of copyright that are set forth in § 106. Copyright laws do not reach identity claims such as Toney's. Identity, as we have described it, is an amorphous concept that is not protected by copyright law; thus, the state law protecting it is not preempted.

We also note that the purpose of the IRPA is to allow a person to control the commercial value of his or her identity. Unlike copyright law, "commercial purpose" is an element required by the IRPA. The phrase is defined to mean

"the public use or holding out of an individual's identity (i) on or in connection with the offering for sale or sale of a product, merchandise, goods, or services; (ii) for purposes of advertising or promoting products, merchandise, goods, or services; or (iii) for the purpose of fundraising."

765 Ill. Comp. Stat. 1075/5. Clearly the defendants used Toney's likeness without her consent for their commercial advantage. The fact that the photograph itself could be copyrighted, and that defendants owned the copyright to the photograph that was used, is irrelevant to the IRPA claim. The basis of a right of publicity claim concerns the message — whether the plaintiff endorses, or appears to endorse the product in question. One can imagine many scenarios where the use of a photograph without consent, in apparent endorsement of any number of products, could cause great harm to the person photographed. The fact that Toney consented to the use of her photograph originally does not change this analysis. The defendants did not have her consent to continue to use the photograph, and therefore, they stripped Toney of her right to control the commercial value of her identity. *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 910 (7thCir. 2005).

¹⁹ Footnote by Standler: The Copyright Act of 1976 requires an "original work of authorship [that is] fixed in any tangible medium of expression" as a condition for copyright. 17 U.S.C. § 1022(a).

Federal Statutes on Unauthorized Recordings of Music

federal civil statute

In 1994, a federal anti-bootlegging statute made *unauthorized* recordings of musical performances a kind of copyright infringement:

(a) Anyone who, without the consent of the performer or performers involved —

(1) fixes²⁰ the sounds or sounds and images of a live musical performance in a copy or phonorecord, or reproduces copies or phonorecords of such a performance from an unauthorized fixation,

(2) transmits or otherwise communicates to the public the sounds or sounds and images of a live musical performance, or

(3) distributes or offers to distribute, sells or offers to sell, rents or offers to rent, or traffics in any copy or phonorecord fixed as described in paragraph (1), regardless of whether the fixations occurred in the United States,

shall be subject to the remedies provided in [17 U.S.C.] sections 502 through 505, to the same extent as an infringer of copyright.

17 U.S.C. § 1101 (enacted 1994, amended 2006, still current July 2013).

This civil statute was found to be constitutional in *Kiss Catalog, Ltd. v. Passport International Productions, Inc.*, 405 F.Supp.2d 1169 (C.D.Cal. 2005).

While I strongly support the goal of this statute, I note the irony that 17 U.S.C. § 1101 provides a tort remedy for infringement of the common-law copyright on a musical performance that was not fixed with permission of the performers. This despite the fact that the Copyright Act of 1976 abolished common-law copyright on works that were fixed and the legislative history severely criticized common-law copyright. See my separate essay on common-law copyright at <http://www.rbs2.com/clc.pdf>.

federal criminal statute

In addition to the above civil remedies in the Copyright Act, there are also criminal penalties for unauthorized recording — or transfer for financial gain of sound recordings and music videos — of live musical performances.

(a) Offense. Whoever, without the consent of the performer or performers involved, knowingly and for purposes of commercial advantage or private financial gain —

²⁰ Note by Standler: *Fix* is a technical term introduced in the Copyright Act of 1976, that means making a permanent, stable copy of an ephemeral or transient performance. In the case of music, the copy is usually on magnetic tape for an analog recording, or a digital data file for a digital recording.

(1) fixes the sounds or sounds and images of a live musical performance in a copy or phonorecord, or reproduces copies or phonorecords of such a performance from an unauthorized fixation;

(2) transmits or otherwise communicates to the public the sounds or sounds and images of a live musical performance; or

(3) distributes or offers to distribute, sells or offers to sell, rents or offers to rent, or traffics in any copy or phonorecord fixed as described in paragraph (1), regardless of whether the fixations occurred in the United States;

shall be imprisoned for not more than 5 years or fined in the amount set forth in this title, or both, or if the offense is a second or subsequent offense, shall be imprisoned for not more than 10 years or fined in the amount set forth in this title, or both.

18 U.S.C. § 2319A (enacted 1994; amended 1997, 2006, 2008; current July 2013).

Upheld as constitutional in *U.S. v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999), *certiorari denied*, 529 U.S. 1036 (2000); *U.S. v. Martignon*, 492 F.3d 140 (2d Cir. 2007).

State Statutes on Unauthorized Recordings

In addition to the federal statutes quoted above, there may also be penalties under state law for unauthorized recordation of live performances. See, e.g.,

- California Penal Code § 653s (enacted 1978) and § 653u (enacted 1984);
- Florida Statute § 540.11(2)(a)(3) (enacted 1971);
- 720 Illinois Compiled Statutes § 5/16-7 (enacted 1961);
- New Jersey Statutes 2C:21-21 (enacted 1991);
- New York Penal Law § 275.00 et seq. (enacted 1978);
- New York Arts and Cultural Affairs Law § 31.01 (enacted 1983) (prohibits unauthorized photographs and sound recordings of performances, has criminal penalties and civil remedies).

Each of these statutes are current in July 2013.

Note that the federal Copyright Act does *not* preempt these state statutes. 17 U.S.C. § 1101(d).

Altered Photographs

The form contract used by photographers tends to be broad and fails to protect the model from either (1) altered or modified images that are both inaccurate and offensive to the model or (2) uses of the photographs in unsavory contexts. An example of the first is copying the head of a svelte model to a different body that is obese. An example of the second is publishing the photographs in obscene magazines or obscene books, or endorsing a product that the plaintiff finds distasteful. The case law on altered photographs is mixed, with many judges ruling that the First Amendment protects publishers in the absence of a contract that explicitly prohibits alterations.

- *Russell v. Marboro Books*, 183 N.Y.S.2d 8, 28-29 (N.Y.Sup. 1959) (Altered photograph used in advertisement suggesting she was a prostitute. Held to state a cause of action for libel and invasion of privacy.);
- *Sharman v. C. Schmidt & Sons*, 216 F.Supp. 401 (D.Penn. 1963) (Athlete who executed model release that permitted use of his photograph “distorted in character, or form” could not complain about his photo appearing in beer advertisements.);
- *Childers v. High Society Magazine, Inc.*, 557 F.Supp. 978, 980 (S.D.N.Y. 1983) (Magazine described by plaintiff as “sleazy, exploitive or pornographic” published copyrighted photographs that plaintiff thought he had licensed to a paperback books on actresses in motion pictures.);
- *Hoffman v. Capital Cities/ABC, Inc.*, 33 F.Supp.2d 867 (C.D.Cal. 1999), *rev'd*, 255 F.3d 1180 (9thCir. 2001) (altered photo of actor Dustin Hoffman in women’s clothing);
- *Hilton v. Hallmark Cards*, 599 F.3d 894 (9thCir. 2010) (Paris Hilton’s head on a cartoon body);
- *Krupnik v. NBC Universal, Inc.*, 37 Misc.3d 1219(A), 2010 WL 9013658 (N.Y.Sup. 2010).

Conclusion

People with audiovisual recording equipment need to have permission to record *any* performance (e.g., music, entertainment, lecture, etc.). The permission should be in writing, on a contract form written by an attorney who is familiar with relevant concepts in copyright law, privacy law, and unfair competition law. Such permission is especially important if there will be any commercial exploitation of the performance.

When someone's name or likeness has been exploited for commercial purposes, lawyers often sue the exploiter under a privacy tort, as explained above at page 10, above. In most cases, a better legal theory would be RESTATEMENT THIRD UNFAIR COMPETITION §§ 46-47 (1995). Some states (e.g., New York, California, Illinois) have statutes on this commercial exploitation, see pages 13-22, above.

When a defendant has made an *unauthorized* recording of a performance, the recording violates the performer's common-law copyright, as explained above at page 9. Violation of this property right is usually litigated under unfair competition. Such *unauthorized* recordings also violate the federal Copyright Act, a federal criminal statute, and may also violate state statutes, see pages 23-24, above.

This document is at **www.rbs2.com/cpermission.pdf**

My most recent search for court cases on this topic was in May 2013
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